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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161817
Party	Defendant Motorola, Inc. Motorola, Inc. 1303 East Algonquin Road Schaumburg, IL 60196
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Date	12/14/2005
Attachments	Applicant's Motion for Summary Judgment Motion to Exhibit 1 (1a of 4).pdf (24 pages)

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on Nov. 11, 2005
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Thomas W. Hiatt
Name of applicant, assignee or
Registered Representative

Signature

Nov. 11, 2005
Date of Signature

Our Case No. 7717/138

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC.,	)	
	)	
Opposer,	)	
	)	Opp. No.: 91/161,817
v.	)	App. No.: 78/235,618
	)	Mark: Sensory Mark
MOTOROLA, INC.,	)	(911 Hz tone)
	)	
Applicant.	)	
	)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Applicant Motorola, Inc., by its undersigned attorneys, hereby moves the Board, pursuant to Rule 56 of the Federal Rules of Civil Procedure and Section 528 of the Trademark Trial and Appeal Board Manual of Procedure, to grant summary judgment in its favor, on the ground that there exists no genuine issue of material fact regarding the

registrability of Applicant's applied-for mark. Consequently, Applicant is entitled to judgment as a matter of law. In support of its motion, Applicant relies upon its supporting memorandum submitted herewith.

Respectfully submitted,

Dated: Nov. 11, 2005

Motorola, Inc.

By _____

John T. Gabrielides
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Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true copy of APPLICANT'S MOTION FOR SUMMARY JUDGMENT was served on counsel for Opposer on Nov. 10, 2005, via First Class Mail, postage prepaid:

Michael H. Jacobs
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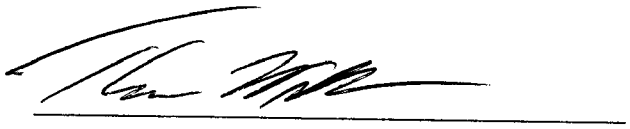

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MEMORANDUM IN SUPPORT OF APPLICANT'S
MOTION FOR SUMMARY JUDGMENT

I. SUMMARY

Nextel has opposed Motorola's application to register a sound mark on the grounds that it has not been used as a mark and that it is not distinctive. However, as discussed below, discovery is closed and Nextel has failed to produce any evidence in the form of

documents, interrogatory responses, deposition testimony, or otherwise, that supports either of its opposition grounds.

Motorola can meet its summary judgment burden by pointing out that there is an absence of evidence to support Nextel's case. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). Motorola has satisfied its summary judgment burden based on Nextel's lack of evidence and the arguments set forth below. Consequently, allowing these proceedings to move forward to trial would be a waste of time and resources.

II. STATEMENT OF FACTS

A. Motorola's Sound Mark

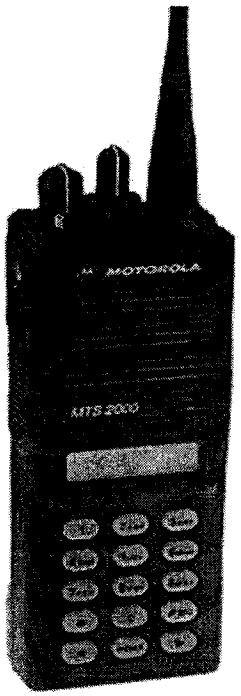
Motorola's sound mark consists of a 911 Hz tone played at a cadence of 25 milliseconds ("ms") ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON. A recording of the sound mark can be heard from the audio CD attached at Exhibit 1.

Motorola created the sound mark in 1983-1984 and selected the mark for its aesthetic quality. (Testimony of Motorola's 30(b)(6) deposition designee, David Klein ("Klein Dep."), at pp. 51, 53, 57-60. A copy of the Klein Dep. transcript is attached at Exhibit 2) Motorola first used the sound commercially as early as May 6, 1991, when it was used in connection with Motorola's two-way radios. (Sensory Mark Application Serial No. 78/235,618.) Motorola has used the sound mark on two-way radios continuously since then. (Ex. 2, Klein Dep. at pp. 12-13, 68.)

The sound is heard when a channel is available for a two-way radio user to communicate with another two-way radio user. (Ex. 2, Klein Dep. at pp. 28, 44-45, 102-103.) Typical users of Motorola's two-way radios include personnel in public safety (*e.g.*,

fire, police, and emergency medical technicians), critical infrastructure sectors (*e.g.*, utility companies), and federal government groups (*e.g.*, Dept. of Defense, Dept. of Justice). (Ex. 2, Klein Dep. at pp. 89-90, 123, 129-132.)

Motorola trains end users of its radios to recognize the sound as coming from Motorola radios. For example, the sound is described in Motorola's user manuals and user guides. It is also heard through a "on-line method" that "actually plays the tone." It is also heard at trade shows where Motorola displays and promotes its two-way radios. In addition, Motorola's two-way radios that emit the sound are prominently marked with the MOTOROLA word mark and design marks. (Ex. 2, Klein Dep. at pp. 45-46, 109-110, 117-118.) A photograph of a Motorola two-radio that emits the sound mark is shown below:



Motorola ensures the consistency of its sound among its two-way radios by, for example, having requirements for the particular pitch and cadence and conducting verification testing of products. (Ex. 2, Klein Dep. at pp. 13-14, 28.)

Motorola's recent annual advertising and promotional budget for its two-way radios that emit the sound includes $100,000 for user groups in the public safety and critical infrastructure sector; $160,000 for materials and presentations for federal government groups; and $600,000 for trade shows for fire and police chiefs and related public safety organizations. (Ex. 2, Klein Dep. at pp. 129-132.)

B. Motorola's Trademark Application

Motorola filed an application to register its sound for use in connection with two-way radios on April 9, 2003 (Ser. No. 78/235,618). Only one Office Action was issued. On October 17, 2003, the Examiner required a revised description of the mark and a substitute specimen, along with a declaration that the substitute specimen was in use in commerce at least as early as April 9, 2003. No other issues were raised.

Motorola addressed the informalities in a response that was received in the Trademark Office on October 20, 2003. Motorola's sound was approved for publication on February 4, 2004, and was published in the *Official Gazette* on February 24, 2004.

C. Nextel's Opposition

Nextel filed its Notice of Opposition on August 23, 2004. The Notice alleges only two grounds for opposition: non-use and lack of distinctiveness. More specifically, Nextel alleges that:

> Upon information and belief, Applicant has not used the 911 Hz tone in commerce in connection with the goods listed in the 911 Hz Tone Application,

in derogation of Sections 1 and 45 of the Lanham Act (Ex. 3, Notice of Opposition at Para. 9); and

Upon information and belief, the 911 Hz tone is not inherently distinctive and has not acquired distinctiveness as to the goods listed in the 911 Hz Tone Application, in derogation of Sections 1, 2, and 45 of the Lanham Act (Ex. 3, Notice of Opposition at Para. 10).

(A copy of Nextel's Notice of Opposition is attached at Ex. 3.)

After Motorola answered the Notice, the parties began taking discovery. Motorola served interrogatories, document requests, and a notice of deposition under Rule 30(b)(6) of the Federal Rules of Civil Procedure, all directed specifically to the two grounds alleged in Nextel's Notice of Opposition.

1. Motorola's Interrogatories

Through interrogatories, Motorola asked Nextel to:

1. Describe in detail all facts relating to Opposer's contention that Applicant has not used Applicant's Mark in commerce in connection with two-way radios (¶ 9 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

After interposing a number of objections, Nextel answered that "it is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios." (Nextel's Interrogatory Responses at Para. 1. A copy of Nextel's Interrogatory Responses is attached as Exhibit 4.) No other substantive answer was provided.

Motorola also requested that Nextel identify the facts that support its allegation that Motorola's sound is not distinctive. Specifically, Motorola requested that Nextel:

2. Describe in detail all facts relating to Opposer's contention that Applicant's Mark is not inherently distinctive in connection with two-way radios (¶ 10 of Notice of Opposition), and identify the three individuals

employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

3. Describe in detail all facts relating to Opposer's contention that Applicant's Mark has not acquired distinctiveness in connection with two-way radios (¶ 10 of Notice of Opposition), and identify the three individuals employed by or on behalf of Opposer who are most knowledgeable about the subject of this interrogatory.

Nextel provided no substantive response to Interrogatory No. 2, choosing instead only to object:

> In addition to the General Objections set forth above, Opposer objects to this interrogatory as it invades the attorney client privilege and/or attorney work product doctrine. Opposer further objects to the user of the term "Applicant's Mark" in that Applicant has not shown that it has used the 911 Hz tone claimed in its application in a manner that qualifies as trademark use in commerce. Opposer further objects that the phrase "inherently distinctive" calls for a legal conclusion. (Ex. 4, Nextel's Interrogatory Responses at Para. 2.)

In response to Interrogatory No. 3, Nextel simply repeated its response to Interrogatory No. 1; Nextel "is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios." (Ex. 4, Nextel's Interrogatory Responses at Para. 3.)

2. Motorola's Document Requests

Motorola issued Document Requests that track its Interrogatories. Motorola requested production of all documents that refer or relate to Motorola's alleged non-use of the sound with two-way radios. After interposing a number of objections, Nextel stated that "it will produce all non-privileged documents and things responsive to this Request." (Nextel's Document Responses at Para. 7. A copy of Nextel's Document Responses is attached at Exhibit 5.)

Motorola also requested that Nextel produce all documents relating to the alleged absence of distinctiveness in Motorola's sound. After again interposing several objections to each Request, Nextel stated that "there are no non-privileged documents responsive to this Request." (Ex. 5, Nextel's Document Responses at Paras. 8-11.)

Motorola also requested that Nextel produce all documents that Nextel identified or referred to in answering Motorola's Interrogatories. Nextel agreed to produce all non-privileged documents and things responsive to these Requests. (Ex. 5, Nextel's Document Responses at Paras. 26 and 27.

On April 29, 2005, Nextel produced a total of 25 (twenty-five) pages of documents in response to Motorola's Document Requests. The documents, which are attached at Exhibit 6, consist solely of the file history for Motorola's trademark application. Nextel also produced a CD-ROM with a .wav file of the tone. (Exhibit 7.) Nextel has not produced any other documents or things in response to Motorola's discovery requests.

3. Motorola's Deposition of Nextel (Rule 30(b)(6))

On July 26, 2005, Motorola took Nextel's deposition under Rule 30(b)(6) to discover the matters known or reasonably available to Nextel on the following topics, among others:

1. The facts on which Opposer bases its contention that Applicant has not used Applicant's Mark in commerce in connection with two-way radios (¶ 9 of Notice of Opposition).

2. The facts on which Opposer bases its contention that Applicant's Mark is not inherently distinctive in connection with two-way radios (¶ 10 of Notice of Opposition).

3. The facts on which Opposer bases its contention that Applicant's Mark has not acquired distinctiveness in connection with two-way radios (¶ 10 of Notice of Opposition).

. . .

17. Surveys, polls, research, or investigations made conducted by, on behalf of, or for the benefit of Opposer that refer or relate to Applicant's Mark or Applicant's two-way radios that use Applicant's Mark.

(A copy of Motorola's Notice of Rule 30(b)(6) Deposition is attached at Exhibit 8.)

Nextel identified Ms. Allison O'Reilly as its designee under Rule 30(b)(6). Ms. O'Reilly is Nextel's Director of Promotions and Retail Marketing. (Testimony of Nextel's 30(b)(6) deposition designee, Allison O'Reilly ("O'Reilly Dep."), at p 6. A copy of the O'Reilly Dep. transcript is attached at Exhibit 9.) When Ms. O'Reilly was asked about Motorola's alleged non-use of the sound, she testified that Nextel has not researched, has not done market studies or focus groups, and has not conducted customer interviews or survey work on whether Motorola has used the sound in commerce. (Ex. 9, O'Reilly Dep. at p. 32.) She also testified that Nextel does not have any documents or correspondence relating to its allegation that Motorola has not used its sound in commerce. (Ex. 9, O'Reilly Dep. at p. 33.)

With respect to Nextel's allegation that Motorola's sound mark is not distinctive, Ms. O'Reilly testified that Nextel has not researched, has not done market studies or focus groups, and has not conducted customer interviews or survey work on whether Motorola's sound is inherently distinctive or has acquired distinctiveness. (Ex. 9, O'Reilly Dep. at pp. 34-37.) She also testified that Nextel has no documents or correspondence relating to the distinctiveness of Motorola's sound. (Ex. 9, O'Reilly Dep. at p. 37.)

Ms. O'Reilly also testified that Nextel does not offer two-way radios. (Ex. 9, O'Reilly Dep. at pp. 27, 46-47.)

Finally, Ms. O'Reilly admitted that she has never heard Motorola's sound. (Ex. 9, O'Reilly Dep. at p. 28.)

Discovery in this case closed on September 13, 2005.

III. ARGUMENT

A. Summary Judgment Is Required Where The Nonmovant Cannot Meet Its Burden Of Proof

Summary judgment is appropriate where there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); T.B.M.P. § 528.01; *Sweats Fashions Inc. v. Pannill Knitting Co., Inc.*, 4 U.S.P.Q.2d 1793, 1795-96 (Fed. Cir. 1987). It is against the public interest to conduct useless trials, and where the time and expense of a full trial can be avoided by summary judgment, such action is favored. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984).

Where the summary judgment movant does not bear the burden of proof at trial, the movant does *not* have the burden to produce evidence showing the *absence* of a genuine issue of material fact. *See Sweats Fashions Inc.*, 4 U.S.P.Q.2d 1795-96. Instead, "the burden of the moving party may be met by showing (that is, pointing out) 'that there is an absence of evidence to support the nonmoving party's case.'" TBMP § 528.01 (*quoting Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986)).

For example, in *Kellogg Co. v. Pack'em Enter., Inc.*, 21 U.S.P.Q.2d 1142, 1144-45 (Fed. Cir. 1991), the Federal Circuit affirmed the Board's grant of summary judgment in applicant's favor because opposer "did not offer any facts relating to the sole issue upon which [applicant] based its motion for summary judgment...." Thus, the Federal Circuit held that "[applicant] carried its burden as a movant under Rule 56 of the Federal Rules of Civil Procedure." *Id.* at 1145 (citing *Celotex,* 477 U.S. at 325). *See also Hornblower & Weeks*

Inc. v. Hornblower & Weeks Inc., 60 U.S.P.Q.2d 1733, 1739 (T.T.A.B. 2001) (granting summary judgment where no evidence was produced).

Mere denials or conclusory assertions by the nonmovant are insufficient to avoid summary judgment. *See* Fed. R. Civ. P. 56(e); *Sweats Fashions Inc.*, 4 U.S.P.Q.2d at 1795.

B. Nextel Cannot Meet Its Burden Of Showing That Motorola Has Not Used Its Sound Mark In Connection With Two-Way Radios

Nextel alleges that Motorola has not used the sound at issue in commerce in connection with two-way radios. (Ex. 3, Nextel's Notice of Opposition at Para. 9.) Nextel has the burden of proving non-use by a preponderance of the evidence. *See generally Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 13 U.S.P.Q.2d 1307, 1309-10 (Fed. Cir. 1989) (holding that preponderance of the evidence is the proper standard in Board proceedings). Nextel cannot meet its burden.

Motorola served discovery requests on Nextel directed specifically to Nextel's allegation of non-use. In response to Motorola's Interrogatory No. 1, Nextel responded that "it is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios." (Ex. 4, Nextel's Interrogatory Responses at Para. 1.) The issue, though, is not whether Nextel is aware of any such use but whether Nextel can show that Motorola has never commercially used the sound as a mark in connection with two-way radios. Nextel's unawareness, even if true, does not establish non-use. At most, it establishes Nextel's unawareness of Motorola's trademark use.[1]

[1] Nextel's unawareness is explained by the fact that Nextel is not in the two-way radio market. (Ex. 9, O'Reilly Dep. at pp. 27, 46-47.)

Motorola also asked that Nextel produce all documents (including things) that refer or relate to Motorola's alleged non-use of the sound with two-way radios. Nextel has produced all non-privileged documents responsive to Motorola's request. However, the only documents that Nextel produced are copies of the documents from the file history of Motorola's application and a .wav file of the sound. (Exs. 6 and 7.) Those documents clearly do not establish non-use of the mark. In fact, they establish the opposite: Motorola's trademark application states that, "The applicant is using the mark in commerce ... on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended." (Ex. 6 at Nextel 0010019.)

Motorola also requested that Nextel provide a witness to testify on, among other things, the facts on which Nextel bases its allegation of non-use. (Ex. 8, Motorola's Notice of Rule 30(b)(6) Deposition at Para. 1.) Nextel's witness, however, was unable to provide any facts or information or to identify any documents that support or even relate to Nextel's contention. The most the witness could say was that she has never heard Motorola's sound mark. (Ex. 9, O'Reilly Dep. at p. 28.) This is insufficient to establish Motorola's alleged non-use of the sound, for the same reason as discussed above with respect to Nextel's answer to Motorola's Interrogatory No. 1: Nextel's unawareness does not establish non-use.

Discovery is closed. By its responses to Motorola's discovery requests and deposition questions directed specifically to the issue of use, Nextel had ample opportunity – indeed, it had the obligation – to fill the record with evidence supporting its allegation of non-use. But Nextel has produced no supporting evidence whatsoever. The complete absence of evidence of non-use requires entry of summary judgment against Nextel on the issue, as the burden of proof of non-use lies exclusively with Nextel. *See* T.B.M.P. § 528.01

("The burden of the moving party may be met by showing (that is, pointing out) 'that there is an absence of evidence to support the nonmoving party's case.'") (*quoting Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986)).

C. Nextel Cannot Meet Its Burden Of Showing That Motorola's Sound Mark Lacks Distinctiveness

Nextel also alleges that Motorola's sound is not distinctive; that is, that it is merely descriptive of two-way radios. (Ex. 3, Nextel's Notice of Opposition at Para. 10.) Nextel has the burden of making a *prima facie* showing that Motorola's sound mark is merely descriptive as applied to two-way radios. *See Omnicom Inc. v. Open Sys. Inc.*, 19 U.S.P.Q.2d 1876, 1878 (T.T.A.B. 1989). If, and only if, Nextel satisfies this burden, then Motorola must demonstrate either that its mark is not, in fact, merely descriptive or that it has acquired distinctiveness. The Board would then decide the mere descriptiveness/acquired distinctiveness issue based on the entire record presented. *Id.*

Nextel cannot meet its burden. Motorola served discovery requests on Nextel directed specifically to Nextel's allegation of non-distinctiveness. Nextel's only substantive response is that "it is unaware of any instances in which Applicant has used the 911 Hz tone as a mark in commerce in connection with two-way radios." (Ex. 4, Nextel's Interrogatory Responses at Para. 3.) But Nextel's unawareness, even if true, does not establish that Motorola's sound is not distinctive. That is a *non sequitur*.

Motorola also asked that Nextel produce all documents and things that refer or relate to the alleged non-distinctiveness of Motorola's sound. Nextel responded that it has no non-privileged documents responsive to Motorola's requests. (Ex. 5, Nextel's Response to Document Requests at Paras. 8-11.)

Motorola also requested that Nextel provide a witness to testify on, among other things, the facts on which Nextel bases its allegation of non-distinctiveness. (Ex. 8, Motorola's Notice of Rule 30(b)(6) Deposition at Paras. 2 and 3.) Nextel's witness, however, was unable to provide any facts or information or to identify any documents that support or even relate to Nextel's contention. (Ex. 9, O'Reilly Dep. at pp. 34-37.)

By its responses to Motorola's discovery requests and deposition questions directed to the issue of distinctiveness, Nextel had ample opportunity – indeed, it had the obligation – to fill the record with evidence supporting its allegation of non-distinctiveness. But Nextel has produced no supporting evidence whatsoever. The complete absence of evidence requires entry of summary judgment against Nextel on the issue of distinctiveness, as the burden of proof of non-distinctiveness lies exclusively with Nextel. *See* T.B.M.P. § 528.01 ("The burden of the moving party may be met by showing (that is, pointing out) 'that there is an absence of evidence to support the nonmoving party's case.'") (*quoting Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986)).

D. Motorola Has Uncontradicted Evidence That Its Sound Mark Is Distinctive And In Use By Motorola

As discussed, Nextel has failed to meet its burden of proving that Motorola's sound mark is merely descriptive of two-way radios. But even if Nextel were somehow able to meet its burden, Motorola has uncontradicted evidence establishing that its sound mark is inherently distinctive and/or has acquired secondary meaning. *See Omnicom,* 19 USPQ2d at 1878.

Simply by playing the sound from the CD attached at Ex. 1, it is clear that Motorola's sound is unique or different, and therefore inherently distinctive. *See In re General Elec.*

Broad. Co., Inc., 199 USPQ 560, 563 (T.T.A.B. 1978). It is not a commonplace sound to which listeners have been exposed under different circumstances (in which case a showing of secondary meaning would be required). *Id.* It is, instead, similar to other unique or different sounds that have been registered without proof of acquired distinctiveness. For example:

> "A series of five chirps similar to the chirping sound of a cricket" registered for "software for notifying consumers of live weather conditions, weather forecasts, weather alerts, and other weather related information by means of a global computer network." Reg. No. 2,827,972. (Exhibit 10)
>
> "The sound of a kiss made when, for example, one is 'blowing a kiss' to another person" for "commercial and residential building construction; building repair; installation of siding." Reg. No. 2,524,758. (Exhibit 11)

In the alternative, even if Motorola's sound were considered commonplace, there is uncontradicted evidence that the sound has acquired distinctiveness. Acquired distinctiveness may be shown by direct and/or circumstantial evidence such as consumer surveys, length of use, and extensive sales and advertising. *See, e.g., In re Owens-Corning Fiberglas Corp.*, 227 U.S.P.Q.2d 417, 422-24 (Fed. Cir. 1985); *In re Instant Transactions Corp. of Am.*, 201 U.S.P.Q. 957, 958 (T.T.A.B. 1979); T.M.E.P. § 1212.06(a)-(d). Motorola's evidence establishes consumer association between the sound and a single source.

As discussed earlier, Motorola first used the sound commercially as early as May 6, 1991, when it was used on two-way radios. Motorola has used the sound on two-way radios continuously since then. (Ex. 2, Klein Dep. at 12-13, 68.) Indeed, Motorola's trademark application states that Motorola "is using the mark in commerce ... on or in connection with the identified goods and/or services." (Ex. 6 at Nextel 0010019.)

In addition, Motorola trains end users of its radios to recognize the sound as coming from Motorola radios. For example, the sound is described in Motorola's user manuals and user guides. It is also heard through a "on-line method" that "actually plays the tone." It is also heard at trade shows where Motorola displays and promotes its two-way radios. In addition, Motorola's two-way radios that emit the sound are prominently marked with the MOTOROLA word mark and design marks. (Ex. 2, Klein Dep. at pp. 45-46, 109-110, 117-118.)

Motorola ensures the consistency of its sound among its two-way radios by, for example, having requirements for the particular pitch and cadence and conducting verification testing of products. (Ex. 2, Klein Dep. at pp. 13-14, 28.)

Motorola's annual advertising and promotional budget for its two-way radios that emit the sound includes $100,000 for user groups in the public safety and critical infrastructure sector; $160,000 for materials and presentations for federal government groups; and $600,000 for trade shows for fire and police chiefs and related public safety organizations. (Ex. 2, Klein Dep. at pp. 129-132.)

In addition, in September 2005, Motorola, through undersigned counsel, commissioned RL Associates to design and carry out a fair and unbiased test of the extent to which (if any) Motorola's sound is associated with a single source. (Expert Report of Michael Rappeport ("Rappeport Report") at MOT 004677. A copy of the Rappeport Report is attached at Exhibit 12.) In-person interviews were conducted with police officers, fire fighters, and emergency medical technicians (EMTs) at their workplaces. (Ex. 12, Rappeport Report at MOT 004679.) The interviews were geographically distributed throughout eight of

the nine census regions of the United States. (*Id.*) The survey was "double blind." (Ex. 12, Rappeport Report at MOT 004682.)

After respondents heard the sound at issue, they were asked whether they knew what the sound was. If a respondent answered that he or she recognized the sound, the respondent was asked whether he or she was thinking of one company who makes the sound or more than one company who makes the sound. (Ex. 12, Rappeport Report at MOT 004681.)

One hundred and sixty four (164) respondents were interviewed. After accounting for "noise" through the use of three different controls (Ex. 12, Rappeport Report at MOT 004680), RL Associates concluded that 42% of the respondents recognized Motorola's sound as coming from a single source. (Ex. 12, Rappeport Report at MOT 004686.) This is legally sufficient to establish that Motorola's sound has acquired distinctiveness. *See Textron, Inc. v. Int'l Trade Comm'n,* 224 U.S.P.Q. 625, 628 (Fed. Cir. 1985) (noting that 40% and 37% respondent recognition levels have been held to be sufficient to establish acquired distinctiveness).

Nextel has not run its own survey on the issue of distinctiveness. Nor has Nextel presented any expert testimony that responds to the survey run by RL Associates. Motorola's survey thus stands uncontradicted.

IV. CONCLUSION

For the foregoing reasons, Motorola respectfully requests that summary judgment be entered against Nextel and that Motorola's Application Serial No. 78/235,618, issue to registration in due course.

Respectfully submitted,

Dated: Nov. 11, 2005

MOTOROLA, INC.

By _____

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of MEMORANDUM IN SUPPORT OF MOTOROLA, INC'S MOTION FOR SUMMARY JUDGMENT was served on counsel for Opposer on Nov. 11, 2005, via First Class Mail, postage prepaid:

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1001 Pennsylvania, Avenue, N.W.
Washington D.C. 20004

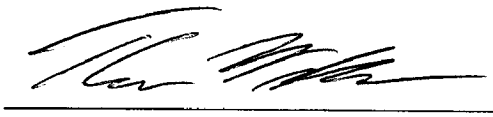


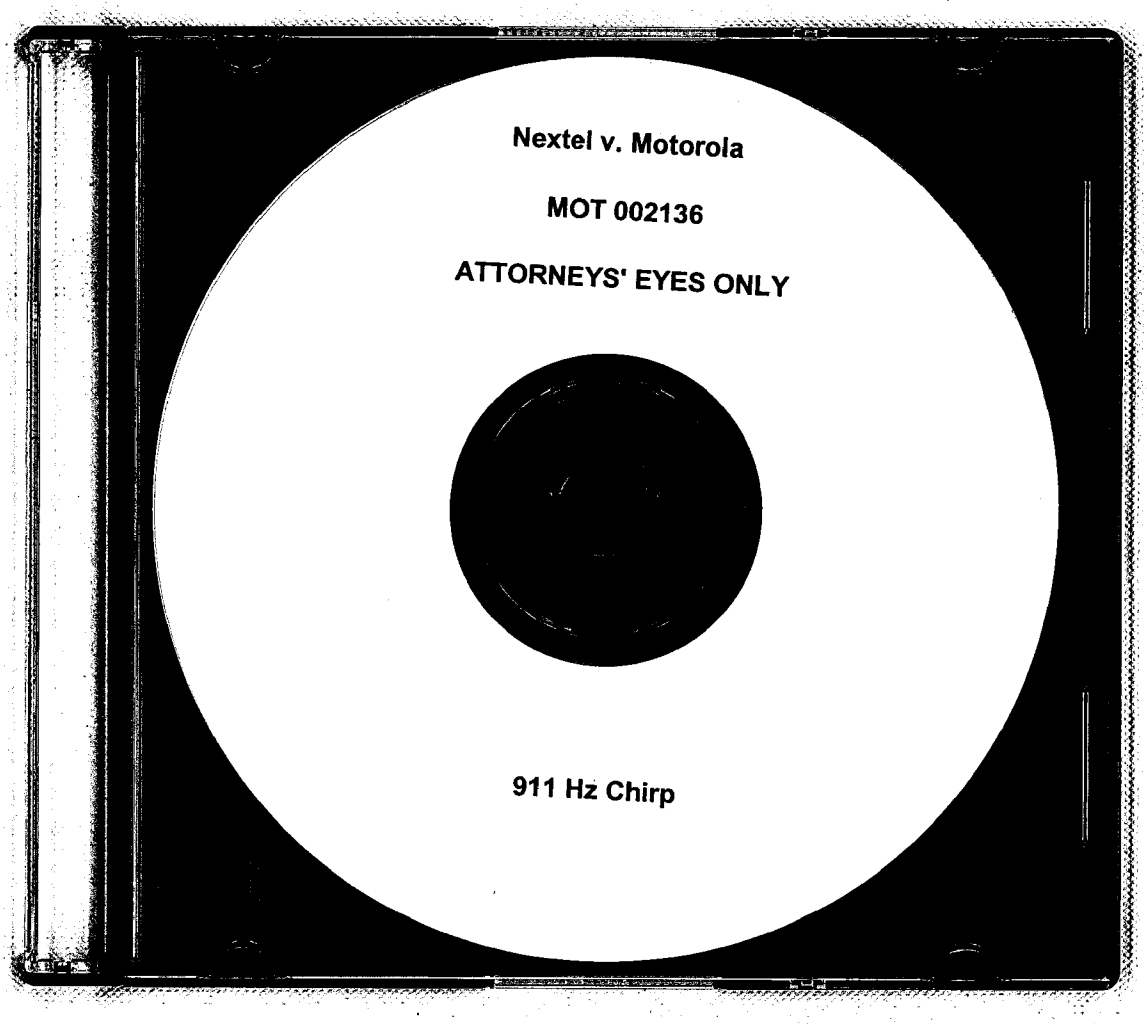
EXHIBIT 1

Nextel Communications, Inc., Opposer, v. Motorola, Inc., Applicant
Opposition No.: 91/161,817
Application No.: 78/235,618
Mark: Sensory Mark (911 Hz Tone)

Exhibit 1 in Support of Applicant's Motion for Summary Judgment

Exhibit 1 is being Express Mailed directly to Ms. Goodman's attention at the TTAB.

Exhibit 1 consists of a .wav file that could not be electronically filed. Exhibit 1 is a CD that contains an audio file for Motorola's 911 Hz Chirp, MOT 002136. A copy of the CD is provided on the following page for reference.


Nextel v. Motorola
MOT 002136
ATTORNEYS' EYES ONLY
911 Hz Chirp